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Appl. No. 09/741,741  
March 23, 2005

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REMARKS/ARGUMENTS

Entry of this amendment as well as reconsideration and allowance of the subject application are respectfully requested.

As a preliminary matter, applicant respectfully requests that the Examiner provide an initialed copy of the PTO-1449 form submitted with the Information Disclosure Statement filed on July 22, 2004.

Claim 17 stands rejected under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, with the Examiner noting an insufficient antecedent basis. Claim 17 has been amended to refer to "a data connection and a voice connection" to overcome those concerns. Withdrawal of the rejection based on 35 U.S.C. § 112, 2<sup>nd</sup> paragraph is respectfully requested.

Claim 7 stands rejected under 35 U.S.C. § 102 as being anticipated by McHale et al. Claim 7 has been canceled without prejudice or disclaimer, and therefore, this rejection is moot.

Claims 1-3 and 8-11 stand rejected under 35 U.S.C. § 103 as being unpatentable over McHale in view of Bremer. These claims are canceled without prejudice or disclaimer, and therefore, this rejection is moot.

Thus, the only outstanding rejection is that of claims 12-22 under 35 U.S.C. § 103 as being unpatentable over McHale in view of Bremer and further in view of Duffie. This rejection is respectfully traversed.

McHale lacks a number of claim features, some of which are admitted by the Examiner, which is why the Examiner must look to secondary and tertiary references in an attempt to shore-up the §103 rejection. For reasons set forth later, this reliance is misplaced. But even if Bremer

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and Duffie were combined with McHale as proposed by the Examiner, for argument's sake, they fail to disclose other features recited in independent claims 12 and 18.

For example, claim 12 recites a user terminal which the Examiner reads on to subscriber 12 in Figure 1 of McHale. Claim 12 also recites a net terminal coupled between the user terminal and an access point. The Examiner fails to identify any element in Figure 1 as corresponding to that claimed net terminal. So the claimed net terminal is not disclosed and is a first missing feature.

In addition, the claimed net terminal includes two different types of modems: "a first high speed, broadband modem" and "a second, lower speed narrow band modem." The Examiner refers to a single modem 30 shown in Figure 1 included in the computer 22. There is no showing of plural modems in subscriber 12, and there certainly is no clear teaching of different types of modems in McHale's subscriber 12. To the contrary, the single modem 30 corresponds to a single type of modem – an XDSL modem. See column 5, line 12 and lines 22-24. Hence, McHale lacks a second claimed feature.

A third feature recited in claim 12 lacking from McHale is an access point (read by the Examiner on to element 58 in Figs. 1 and 2 of McHale) which includes two different types of modems: "one or more high speed, broadband modems" and "one or more lower speed broadband modems." McHale's access point 58 only describes a single modem pool 74 and that modem pool 74 only includes one type of modems – XDSL modems. See column 8, lines 22-24, lines 33-35 and lines 58-60.

Thus, McHale lacks three features from the independent claims, and these features are not disclosed or suggested in Bremer or Duffie. Bremer shows the customer premise 22

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including only a single modem 20. There is no teaching in Bremer of multiple modems or modems of different types in customer premise 22. Similarly, the central office 24 only contains a single modem 40. Bremer also does not teach switching between two different types of modems. Duffie describes a system for testing copper loops and lines and is not used for providing access to telecommunication services for users. Based on these three missing features, the rejection of claims 12-22 is improper and should be withdrawn.

Applicant also objects to the Examiner's hindsight selection of certain features taken from Bremer and Duffie in an attempt to show the claimed first and second circuitry and the claimed controller for controlling the first and second circuitry as recited in the independent claims. The claimed first and second circuitry and the claimed controller are admitted by the Examiner to be missing. This brings the number of missing claim elements to five. As a practical matter, since McHale, Bremer and Duffie lack the two different type modems in the claimed net terminal and the claimed access point, there is no reasonable way to reconstruct the claimed first and second switching circuitry and controller from these three references.

The Examiner relies on the analog front end 66 of Bremer's modem 20 as allegedly teaching the claimed first switching circuitry. As explained in the description of Figure 5 beginning at column 10, line 38, the analog front end element 66 includes a switch 110 controlled by a controller 80 to change the state of the phone from on-hook to off-hook. Applicant respectfully submits that switching a resistor 108 in and out of a circuit depending upon whether the telephone is in on-hook and off-hook mode is simply not relevant to directing signals to and from the user terminal via the communications network using a selected one of the first and second modems contained in the net terminal.

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Duffie is even farther removed than Bremer since it merely teaches a testing device with various bypass functions to facilitate testing operations. The fact that the Examiner has found a reference shows a controller controlling first and second switches in a context that has nothing to do with what is recited in the independent claims is the epitome of improper hind-sight reconstruction. The motivation advanced by the Examiner to incorporate the teaching of Duffie and McHale is to "monitor loop qualification trouble-shooting and voice portion of the loop." But this motivation has nothing to do with what is recited in the independent claims. A proper motivation to combine requires an appreciate of the desirability of making the combination. It is not measured by the feasibility of making the combination. See *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 (Fed. Cir. 2000). The Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and no knowledge of the claimed invention, would select the elements from the cited prior art references for the combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). The Examiner has failed to make such a showing in this case.

Thus, there are multiple reasons why the rejection of the independent claims 12 and 18 are improper. There are also a number of dependent claim features which are also not disclosed or suggested. For example, claims 14 and 19 recite controlling "the first and second switching circuitry to select the second modem and the one narrow band modem if or when the connection cannot be supported as desired between the first modem and the one broadband modem." The Examiner relies upon Duffie at column 5, lines 43-47, as allegedly teaching this feature. Yet this text says nothing about selecting a different type of modem set from the type of modem set currently being used "if or when the connection cannot be supported at desired" using the current

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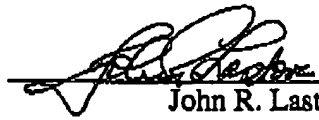
type of modem set. All this language in Duffie says is that the test equipment 8 can be used for loop qualification, trouble-shooting, and monitoring, that the loop qualification can be performed in the central office, and that test equipment 8 can be used to monitor the loop status. The Examiner's rejections of claims 15, 16, 17, 20, 21, and 22 based on this same text in Duffie is likewise flawed.

The application is in condition for allowance. An early notice to that effect is earnestly solicited.

Respectfully submitted,

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